



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/601,468 | 06/23/2003 | Alex J. Draughon | 60655.1200 | 7233 |

5514 7590 10/06/2006

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

PICH, PONNOREAY

ART UNIT PAPER NUMBER

2135

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/601,468 | Applicant(s) DRAUGHON ET AL. | |
| | Examiner Ponnoreay Pich | Art Unit 2135 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>1/04; 2/05; 2/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-8 are pending.

Priority

Priority claim to provisional application US 60/465815 is acknowledged.

Information Disclosure Statement

Documents listed in the IDS's submitted by applicant have been considered.

Claim Objections

Claim 6 is objected to because of the following informalities: As per claim 6, "said web site" should be recited instead of "said site". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Montville et al (US 6,356,937).

Claim 8:

Montville discloses a first message associated with a first identifier and a second identifier, wherein said first identifier is associated with a first user and said second

Art Unit: 2135

identifier is associated with a second user (col 21, lines 49-51; col 24, lines 37-42; and col 24, lines 55-67).

Note that Montville discloses an email system, which stores emails via use of a database. Email contains a "From" field which identifies the first user and reads on a first identifier. Email also contains a "To" or "Recipient" field which reads on a second identifier associated with a second user.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montville et al (US 6,356,937) in view of Meyer (US 6,148,329).

Claim 1:

Montville discloses:

1. Storing the message in a database (col 27, lines 37-42).
2. Associating the message with at least one intended recipient by at least one identifier (col 16, lines 1-13 and col 21, lines 49-51).
3. Providing a web site for the recipient to view the message (col 5, lines 38-40 and col 15, lines 50-55).
4. Authenticating the recipient using a second identifier (col 6, lines 38-42 and col 26, lines 34-40).

5. Searching the database to find messages associated with the recipient by matching said at least one identifier (col 24, lines 55-67).
6. Displaying the messages associated with the recipient (col 26, lines 51-55).

Montville does not explicitly disclose the following limitation, which is disclosed by Meyers: notifying the intended recipient of the message for said recipient which is stored in the database (col 1, lines 14-21).

At the time applicant's invention was made, it would have been obvious to one skilled in the art to incorporate Meyers's teachings within Montville's invention according to the limitations recited in claim 1. One skilled would have been motivated to do so because message alert is a common feature in many email client at the time applicant's invention was made. It allows a user to know when new messages are available without constantly having to manually check.

Claim 2:

Montville further discloses wherein said first identifier is an account number (col 11, lines 8-11).

Claim 3:

Montville further discloses wherein said second identifier is a combination of a user identification and a password (col 6, lines 38-42 and col 26, lines 34-40).

Claim 5:

Montville further discloses wherein said message comprises: a message portion; and an attachment file in a format that is different from said message portion (Fig 13; col 23, line 61-col 24, line 4; and col 24, lines 17-19).

Claim 6:

Montville further discloses encrypting said site to view messages using an encryption method (col 25, lines 44-53).

Claim 7:

Montville further discloses wherein said encryption method is SSL (col 25, lines 44-53).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montville et al (US 6,356,937) in view of Meyer (US 6,148,329) and further in view of Fung et al (US2002/0055909).

Claim 4:

As per claim 4, Montville and Meyers does not disclose said second identifier is a biometric identification system. However, Fung discloses an identifier being a biometric identification system (paragraphs 148-149).

At the time applicant's invention was made, it would have been obvious to one skilled in the art to further modify Montville's invention such that he second identifier is a biometric identification system. One skilled would have been motivated to do so

because biometric authentication allow for greater confidence in verifying someone's identity (Fung: paragraph 148).

Conclusion

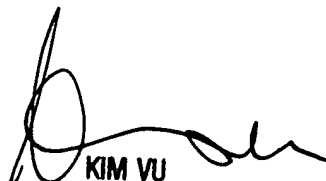
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ponnoreay Pich
Examiner
Art Unit 2135

PP


KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100